

Application No. 09/920,435
Filed: August 1, 2001
Group Art Unit: 1639
Confirmation No.: 6450

REMARKS

In the Advisory Action, the Examiner stated the following reasons for his denial of entry of the After-Final amendment:

1. Claim 1 (currently amended) inserts new claim limitations (e.g., "complex biological material"), which introduces the issue of new matter. Furthermore, this limitation was not previously set forth and would require additional search and consideration.
2. There is no reason given for why the amendment was not earlier presented.

The rejections behind these comments are respectfully traversed and reconsideration is requested.

First, the Applicants respectfully remind the Examiner that the reason for the requested language change is that in the Final Office Action, the Examiner rejected claims 1 and 14 for use of the term "natural," saying that this term was indefinite. In the Amendment submitted March 2, 2004, the Applicants traversed the rejection but then amended the indicated claims to address the Examiner's concerns. Accompanying this paper and in support of the use of the new term, Applicants enclose pages from three different patents - U.S. Patent No. 5,783,397, U.S. Patent No. 6,299,747 and U.S. Patent No. 6,524,866 - showing that the use of the term "complex biological material" to encompass "natural samples" is conventional within the art. In the set of pages for each patent, sections showing the use of the term "complex biological material" to encompass "natural samples" are marked. In addition, as shown in claim 1 of each patent (also marked), the term "complex biological material" is used to indicate the material sampled.

-2-

WEINCARTEN, SCHURGIN,
GAGNEDIN & LEBOVITZ LLP
TEL. (617) 542-3280
FAX. (617) 451-0312

Application No. 09/920,435
Filed: August 1, 2001
Group Art Unit: 1639
Confirmation No.: 6450

As to the issue of new matter, the Examiner is referred to p. 1, lines 17-20, of the instant application, where "natural samples" are given as an example of "complex biological materials, and to p. 5, lines 9-11, where it is stated that "[t]he present invention provides an improved method of rapidly extracting, from complex biological materials such as natural samples," Thus, any rejection of the requested language for being new matter has been overcome.

Applicants respectfully request reconsideration and withdrawal of the foregoing rejection.

Based on the foregoing, entry of the amendments and remarks presented herein (and of the previously presented amendments and remarks), reconsideration and withdrawal of all the rejections and allowance of the application with all pending claims are respectfully requested.

The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

YURIY M. DUNAYEVSKIY ET AL.

By: Holliday C. Heine
Holliday C. Heine, Ph.D.
Registration No. 34,346
Attorney for Applicant(s)

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
Ten Post Office Square
Boston, MA 02109
Telephone: (617) 542-2290
Telecopier: (617) 451-0313

HCH/raw
308197-1

-3-

WEINCARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
TEL. (617) 542-2290
FAX (617) 451-0313